

## **REMARKS**

### **Amendments to the Claims**

Claims 3-31 were pending in the present application. Claims 3, 13, 15 and 31 have been amended. New claims 32 and 33 have been added.

Claim 3 has been amended to claim the subject matter which Applicants regard as the invention with greater clarity. Claims 13 and 15 were amended to change the dependency of the claim to depend from claim 3 only. New claims 32 and 33 were added to claim subject matter that was removed from claims 13 and 15 respectively. Support for these amendments can be found in original claims 13 and 15 and throughout the specification.

Claim 31 has been amended to more clearly define a subset of the compounds of formula 3 and to more clearly define the method. Support for this amendment can be found in previously filed claim 31 and throughout the specification. See e.g. page 85, paragraphs 104 and 105.

Accordingly, upon entry of this amendment claims 3-33 will be pending in the application. None of the amendments introduces new matter.

### **Provisional Obviousness-Type Double Patenting Rejection**

Claim 3 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending United States patent application 11/121851.

Because this rejection is provisional, Applicants reserve the right (1) to file a terminal disclaimer and/or (2) to traverse the rejection. However, in view of the amendment to claim 3, reconsideration of this provisional rejection is requested.

### **Rejections under 35 U.S.C. § 112, second paragraph**

Claims 13-16 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which the applicant regards as the invention. The Office Action states that claim 13 is recited to be dependent on claim 4 (or else claim 3) and that only one of the compounds (compound # 189) recited in claim 13 is subgeneric to claim 4. Applicants have amended claim 13 to depend from claim

3 only, and placed compound 189 into new claim 32 as recommended by the Examiner in the Office Action. The Office Action also states that none of the compounds in claim 14 or 15 are subgeneric to claim 4. Applicants have amended claim 15 to depend from claim 3 only, and placed the subject matter that was subgeneric to claim 4 in new claim 33.

Accordingly, for the foregoing reasons, applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

#### **Rejections under 35 U.S.C. § 102**

Claims 3, 5, 6, and 10-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Abbott (USP 4,537,717), hereafter Abbott.

#### **Compound 23 of Abbott**

The Office Action states that compound 23 of Abbott is encompassed by claim 3 of the pending application when substituent variables are as follows:

$R = N(B)(X)_m-A$ , wherein B=hydrogen; X = -CO-; A=alkyl;

$R^1 = N(B')(X')_m-A'$ , wherein B'=hydrogen, m=0, X' is not present; A'=C<sub>12</sub>-alkyl which is substituted with an oxo;

$R^2 = -CH_2-CO-$ aminophenyl.

Applicants have amended claim 3 to more clearly define the proviso by defining an (X')<sub>m</sub>-A' unit rather than X', m and A', individually. As amended, proviso (c) overcomes this rejection.

#### **Structure at col. 5, line 40+ of Abbott**

The Office Action also states that the structure at column 5, line 40+ of Abbott is encompassed by instant claim 3 when the variables that make up R<sup>1</sup> are as follows: B'=hydrogen; m=0; X' = >C=S and A'=t-butyloxy carbonyl. As stated above, Applicants have amended claim 3 to more clearly define the proviso by defining an (X')<sub>m</sub>-A' unit rather than X', m and A', individually. As amended, proviso (g) overcomes this rejection.

Accordingly, for all of the foregoing reasons, applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b).

#### **Amendment of Claim 31**


Applicants have amended claim 31 to recite process steps to advance prosecution as suggested by the Office Action.

**CONCLUSION**

For the reasons presented above, Applicants respectfully request reconsideration and prompt allowance of all pending claims. A Petition for Extension of Time is enclosed. Please deduct the fee of \$510 for the Petition and apply any other charges or credits to Deposit Account No. 50-1986, referencing attorney docket number C059 US.

Respectfully submitted,

Date: 7/27/06  
Cubist Pharmaceuticals, Inc.  
65 Hayden Avenue  
Lexington, Massachusetts 02421  
Tel.: (781) 860-8660  
Fax: (781) 860-1407

  
Timothy J. Douros, Reg. No. 41,716  
William D. DeVaul, Reg. No. 42,483  
Attorneys for Assignee  
Jill M. Mandelblatt, Reg. No. 37,878  
Patent Agent for Assignee